

REMARKS

This is in reply to the Examiner's Official Action dated May 6, 2003. Prior to this Amendment, claims 1-20 were pending. By this Amendment, claims 1 and 9 have been amended to more appropriately claim the invention. Thus, claims 1-20 are pending. The above amendment with the following remarks are submitted to be fully responsive to the Official Action. Reconsideration of this application in light of these remarks, and allowance of this application are respectfully requested.

I. **Revocation of Original Power of Attorney and Grant of New Power of Attorney**

On March 25, 2003, Applicants mailed the attached Revocation of Original Power of Attorney and Grant of New Power of Attorney to the U.S. Patent and Trademark Office (PTO). To date, we have not received a notice from the PTO that revokes the previous power and grants a power of attorney in Finnegan, Henderson et al. Applicants respectfully request the Examiner take the necessary steps to effect the requested revocation/grant, and update the correspondence address to reflect the new grant of the Power of Attorney.

II. **Rejection of Claims Under 35 U.S.C. § 102(b)**

On page 6 of the Official Action, the Examiner rejected claims 1-20 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,848,373 to DeLorme et al. (hereinafter, DeLorme). According to the Examiner, DeLorme discloses:

in Fig. 6, (first and second maps) a view of the CAMLS system with desktop PC or workstation programmed for printing strip maps or "trip tickets" showing proposed routes of travel from a point of origin to a destination. DeLorme discloses in (col. 42, lines 34-51) conversion

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routines for raster data, symbols & annotations an array of conversion routines for conversion of raster data consisting of mapping graphics and related text, derived from input devices such as scanned in paper maps, message pads, digitizing tables, graphics and CAD programs, fax and wireless data transmissions into standard CAMLS data structures.

(Official Action of April 24, 2003 at page 6.) The Examiner admits that DeLorme fails to teach, suggest or disclose all of the claim limitations, when he provides that “[t]he step of determining a mathematical relationship between the image coordinates and the geographic coordinates is inherent because a user marks the origin and the destination on the map.” (Id.) The Examiner rejected independent claim 9 for reasons similar to those set forth in rejecting claim 1. Applicants disagree with the Examiner's characterization of the prior art, and therefore traverse the Examiner's rejection of independent claims 1 and 9.

Claim 1 recites a method for georeferencing a raster map image, comprising: displaying a raster map and a georeferenced map; annotating a point on the raster map; identifying image coordinates associated with the annotated point on the raster map; annotating a point on the georeferenced map; identifying geographic coordinates associated with the annotated point on the georeferenced map that correspond to the annotated point on the raster map; repeating annotating a point on the raster map identifying image coordinates associated with the annotated point on the raster map, annotating a point on the georeferenced map, and identifying geographic coordinates associated with the annotated point on the georeferenced map at least a second time; and determining a mathematical relationship between the image coordinates and the geographic coordinates.

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The Examiner does not argue, and DeLorme does not teach, disclose or suggest annotating a point on the georeferenced map, or identifying geographic coordinates associated with the annotated point on the georeferenced map that correspond to the annotated point on the raster map, as recited in claim 1.

In DeLorme:

[t]he user enters current location and proposed destination. Alternatively, with a GPS receiver and capability, the current location of the user is derived from GPS data and the user enters a proposed destination. The user location and proposed destination are displayed on an appropriate grid quadrangle on the graphics display window of the PDA for correlation with locations depicted in detail on a corresponding printed map. The grid quadrangle is selected at an appropriate grid level to encompass both current location and proposed destination. The user then asks for a proposed route or alternate routes to the destination which may be derived from a database of routes, e.g. on a supplemental memory device.

(DeLorme at col. 22, line 67 - col. 23, line 12.) (Emphasis added.)

In other words, according to DeLorme, a user enters a current location and a proposed destination, and then queries the system for a route from the current location to the proposed destination. The user does not annotate a point on the raster map and a point on the georeferenced map (i.e., the trip ticket of DeLorme) because both points (start/destination) are on the same map. Therefore, DeLorme fails to disclose these steps of claim 1.

The Examiner admits that at least one of the claim limitations in independent claims 1 and 9 is not disclosed, taught, or suggested by DeLorme, and he alleges that it would have been inherent in DeLorme. Applicants respectfully disagree.

To properly show that an element not disclosed in DeLorme is, in fact, inherent in that reference, the Examiner should cite extrinsic evidence, such as an extra reference,

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that describes the inherent element. See MPEP § 2131.01(III) (8th Ed. 2001). "Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill." Id. Inherency, however, may not be established by probabilities or possibilities. See MPEP § 2163.07(a).

In this case, the Examiner provides no reference or other evidentiary basis to support the inherency allegation. Even if the Examiner provided a second reference that discloses the process of determining a mathematical relationship between the image coordinates and the geographic coordinates, as recited in claim 1, the teachings of the second reference could not be inherent in DeLorme, as would be necessary in order to establish anticipation of the subject matter of the claim, because as previously stated, DeLorme does not teach, disclose or suggest the step of annotating a point on a georeferenced map. Since there are no annotated points on the georeferenced map, there are no associated geographic coordinates from which a mathematical relationship may be determined.

Therefore, DeLorme fails to teach each and every limitation of claim 1. For at least this reason, claim 1 is patentable over DeLorme.

Independent claim 9 is directed to an apparatus including features generally corresponding to those of claim 1 and patentably distinguishing over DeLorme for the same reasons as explained in claim 1.

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For the above reasons, independent claims 1 and 9 are patentable over DeLorme. Claims 2-8 and 10-20 are at least patentable based on their dependency from claims 1 and 9.

Even though the cited reference fails to reach the teachings of Applicants' device, Applicants have nevertheless amended claims 1 and 9 to more appropriately describe Applicants' invention. Applicant contend that the claims as amended, still patentably distinguish over the prior art. Therefore, the rejection of independent claims 1 and 9 under 35 U.S.C. §102(b) as anticipated by DeLorme should be withdrawn. The rejection of dependent claims 2-8 and 10-20 should also be withdrawn as they depend on allowable subject matter as recited in the respective independent claims from which they directly or indirectly depend.

III. Conclusion

In view of the foregoing, it is submitted that the cited prior art fails to teach or suggest the Applicants' invention. Therefore, it is respectfully asserted that the present application is in condition for allowance and a notice to that effect is respectfully requested. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims. If the Examiner deems that any issue remains after considering this response, he is invited to call the undersigned to expedite the prosecution and work out any such issue by telephone.

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 6, 2003

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